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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,395	09/25/2001	Harald Jakob	P 265258 000345 PV	5500

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EXAMINER
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LISH, PETER J

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/961,395	JAKOB ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter J Lish	1754	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 5/6/04 have been fully considered but they are not persuasive. Applicants argue, with respect to the rejection under 35 USC 112 first paragraph, that the examples show the use of complexing agents without the presence of a condensed phosphate and therefore the amended limitation excluding the use of a condensed phosphate is supported. However, the examiner maintains that the showing of examples using complexing agents and lacking a condensed phosphate does not alone represent sufficient support for a negative limitation excluding their combined use. The specification and original claims are clearly specific that the combination of a magnesium salt and a condensed phosphate alone is excluded.

Applicants argue, with respect to the rejection over Bewersdorf et al., that Bewersdorf does not teach, nor provide motivation for, the use of both magnesium salts and waterglass. However, Bewersdorf explicitly states that additives (plural) may be added and furthermore that magnesium salts are usually added to the peroxide solution while waterglass is usually added to the soda solution. Additionally, it is held that the practice of combining two useful compositions to form a third composition used for the same purpose is obvious, see *In re Kerkhoven*, 205 USPQ 1069.

Applicants additionally argue, with respect to the rejection over Bewersdorf et al., that Bewersdorf neither teaches the composition of the waterglass, nor a motivation to optimize the composition of the waterglass. However, given the fact that different compositions of waterglass are known in the art, it is held by the examiner that it would have been obvious to one of

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ordinary skill at the time of invention to determine, through routine experimentation, which composition of waterglass provides the most desired effect.

Applicants additionally argue, with respect to the rejection over Bewersdorf et al., that the expectation of properties corresponding to those claimed by the applicant is improper, because the properties depend upon the amounts of additives used, which is not taught by Bewersdorf et al. However, it is noted that the amount of additives used in the process of Bewersdorf is discussed in the rejection as being an obvious optimization of a known process.

Applicants argue, with respect to the rejection over Bewersdorf et al. ('896) in view of Bewersdorf et al. ('201), that the reference to Bewersdorf ('201) discusses a different "type" of stability from that of the applicant. However, it is noted that the "type" of stability that Bewersdorf ('201) discusses, active oxygen stability, is the same as that discussed by Bewersdorf ('896), therefore the combination of the rejection is proper. Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

Claims 1-3, 5,7-9, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bewersdorf et al. (US 5,560,896).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 1-3, 5,7-9, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bewersdorf et al. ('896) in view of Brichard et al. (US 4,428,914).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 1-3, 5,7-9, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bewersdorf et al. ('896) and further in view of Bewersdorf et al. (USPN 5,714,201).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bewersdorf et al., Bewersdorf et al. in view of Brichard et al., or Bewersdorf et al. ('896) in view of Bewersdorf et al. ('201) as applied to claim 1 above, and further in view of Horne et al. (US 6,413,927).

Bewersdorf et al. teaches that the stabilizing additives may include complexing agents. Bewersdorf et al. does not explicitly teach the list of complexing agents useful as stabilizers.

Horne et al. teaches that the percarbonate particles may include a variety of stabilizers, including magnesium salts, alkali silicates (i.e. waterglass), and many of the complexing agents listed in claim 4 (column 6, lines 7-25). It would have been obvious to one of ordinary skill to use a complexing agent from the list of useful stabilizers taught by Horne et al., in the process of Bewersdorf et al., as they meet the desired effect of providing stabilization to the products.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Lish whose telephone number is 571-272-1354. The examiner can normally be reached on 9:00-6:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**STUART L. HENDRICKSON**  
**PRIMARY EXAMINER**